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#16 Reply Brief
7/21/04

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PATENT APPLICATION
Docket No. 2291.2.2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Michael L. Howard et al.
Serial No.:	09/887,626
Filed:	June 22, 2001
For:	ELECTRONIC DEVICE WITH PAGING FOR ENERGY CURTAILMENT AND CODE GENERATION FOR MANUAL VERIFICATION OF CURTAILMENT
Examiner:	Edwin C. Holloway, III

Group Art Unit: 2635

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A final Office Action dated April 11, 2003 rejected all claims (claims 1-26) in the present application. A timely Notice of Appeal was mailed on October 10, 2003 and was received by the United States Patent Office on October 14, 2003. Appellants' Appeal Brief has been filed. The Examiner's Answer was mailed on May 6, 2004. This Reply Brief is being filed in triplicate under the provisions of 37 C.F.R. § 1.192.

ARGUMENT

The Examiner has withdrawn the rejections of claims 1-26 under 35 U.S.C. § 103(a) based on Glorioso et al, U.S. Patent No. 5,926,776 (hereinafter, "Glorioso") in combination with Von Kohorn, U.S. Patent No. 5,128,752 (hereinafter, "Von Kohorn"). Examiner's Answer, Page 6. In addition, the rejections relying on Nierlich, Wilson and Chainer have also been withdrawn. Id. The rejection based on Glorioso, Von Kohorn and Hunter (U.S. Patent No. 5,243,654, hereinafter, "Hunter") remains.

The combination of Hunter and Von Kohorn is an improper combination. The Hunter reference requires manual verification. "A metering system requires a user to provide periodic, accurate meter readings to a billing authority." Hunter, Abstract. "A metering system as just described provides a convenient way to require a customer to provide accurate and timely meter readings." Id., Col. 3, lines 21-23. "The data exchange occurs via the user, who reads data from user interface 30 of meter 10, places a telephone call to data center 20, conveys meter data to data center 20, receives resetting data from ARU 44, and inputs the resetting data into meter 10 through interface 30." Id., Col. 4, lines 36-41. "The routine is initiated by receipt of a telephone call from a user. At step 300, data center 20 receives and verifies identifying information, which may, for instance, include the user's account number and/or a meter serial number. Then, at step 302, data center 20 receives the current meter reading from the user and verifies that the reading is at least approximately accurate." Id., Col. 8, lines 37-44.

As more fully argued and explained in Appellant's Appeal Brief, Glorioso does not teach or suggest manual verification. Glorioso states the following:

> The transceiver transmits information for the control signal, temperature setpoints and associated costs to the energy provider. The energy provider may then predict the effect a change to the current energy price will have on energy demand, ***influence the demand in real time by adjusting the energy price, and verify from the smart thermostat that the demand was effected.***

Glorioso, Abstract. Glorioso further states:

> The receiver 64 receives user status information from the smart thermostat 10 including information for the control signals, temperature, temperature points set by the user, acceptable energy costs associated with each of the temperature setpoints and passes the information to the computer system 62. The computer

> system 62 then recomputes the current energy price based upon the user temperature setpoints and the associated acceptable energy cost levels in order to adjust the demand for energy according to the supply and passes the adjusted current energy price levels to the transmitter 66 to be issued via the communication network 50.

Glorioso, Col. 4, lines 59-67 and Col. 5, lines 1-3. Glorioso monitors supply and demand in real-time and adjusts the price accordingly. The manual verification and communication of Hunter would not only not work in Glorioso, but it would destroy the very purpose of the invention in Glorioso because it could not monitor supply and demand in real-time and adjust the prices and further send these prices to users in real-time.

A prima facie case of obviousness has not been established because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Glorioso monitors supply and demand in real-time and adjusts the price accordingly. Manual verification would not only not work in Glorioso, but it would destroy the very purpose of the invention in Glorioso because it could not monitor supply and demand in real-time and adjust the prices and further send these prices to users in real-time. Thus there is no suggestion or motivation to combine the reference teachings. Much, if not all, of the technology of Glorioso would be utterly wasted if combined with Hunter in this way.

After a provider would have allocated the necessary resources to implement and use the system of Glorioso, there would be no incentive to then require user's to manually communicate the readings to the provider as shown in Hunter. These communications are readily handled automatically by Glorioso and provide real-time information for the provider. There is clearly no incentive for the provider to discard this information, not use this functionality, and require all user's to manually communicate the information to the provider manually. Such a combination of Hunter and Glorioso makes no sense and no one skilled in the art would so combine these references.

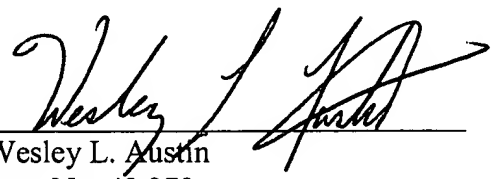
The claimed invention must be considered as a whole. M.P.E.P. § 2143. The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. M.P.E.P. § 2143. The Examiner has not considered the references as a

whole. As pointed out above, when the references are considered as a whole it is clear that not only is there no motivation to combine the two, but any combination of the Hunter system with Glorioso would destroy the very purpose of Glorioso. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The proposed modification cannot render the prior art unsatisfactory for its intended purpose. M.P.E.P. § 2143. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As stated above, Glorioso monitors supply and demand in real-time and adjusts the price accordingly. A combination of Hunter with Glorioso would render Glorioso unsatisfactory for its intended purpose because it could not monitor supply and demand in real-time and adjust the prices and further send these prices to users in real-time.

Appellants note that claim 1-26 stand or fall together. Therefore, for the reasons discussed above, Appellants assert that the rejection of claims 1-26 is improper. Reversal of the Examiner's rejections and allowance of the pending claims is respectfully requested.

Respectfully submitted,



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Date: July 6, 2004

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